

**Notice of Allowability**

Application No.

09/926,010

Examiner

Daniel A. Hess

Applicant(s)

HAGHIRI ET AL.

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 3/4/2005 interview with applicant.
2. ☒ The allowed claim(s) is/are 1-3.
3. ☒ The drawings filed on 14 August 2001 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All   b) ☐ Some\*   c) ☐ None   of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

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## **DETAILED ACTION / REASONS FOR ALLOWANCE**

### ***Remarks***

This action is in response to a telephonic discussion with the applicant's representative regarding the instant case on 3/4/2005 and 3/7/2005. An interview summary is attached herewith.

Double patenting rejections are hereby withdrawn, for reasons that are discussed in *Reasons for Allowance*, provided below.

## **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Ernest Kenney on 3/21/05.

The application has been amended as follows:

1. (Amended) A portable data carrier (1) comprising:

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a break-out mini smart card (2), the mini smart card (2) being largely separated from the remaining carrier card body by a free punch (3) extending over substantial parts of the mini smart card and

a rated breaking line (5) disposed within the mini smart card (2) configured, located and dimensioned so as to enable the size of the mini smart card (2) to be further reduced to create a miniaturized mini smart card;

the break-out direction given by the rated breaking line (2) for the mini smartcard out of the portable data carrier being different from the break-out direction for the miniaturized mini smart card.

2. (Previously presented). A portable data carrier according to claim 1, including bars (6) interrupting the free punch line (3) disposed in the edge areas of the mini smart card (2) at the same level.

3. (Amended). A portable data carrier according to claim 1 or 2, wherein the bars (9) within the mini smart card have higher strength than the bars (6) connecting the mini smart card with the remaining carrier card body.

***Allowable Subject Matter***

Claims 1-3 are allowed.

The following is an examiner's statement of reasons for allowance: The applicant argued that the obviousness double patenting rejection based on US Patent No. 6,561,432 was not appropriate because in the above patent there is no disclosure that a breakout direction for the miniaturized mini smart card out of the mini smart card is different from the breakout direction for the mini smart card out of the larger overall card. The applicant pointed out that the term "break-out" could not be interpreted as expressed in the rejection by the examiner, as "break-out" means separating a card from the larger card to which it is attached and should not be construed to involve pre-cutting the card material to form weakened connections.

The examiner observes that this position indeed finds support in the specification. Notably, on page 2, the specification recites, "Free punch 5 with bars 9 has a different break-out direction from free punch 3 with connecting bars 6 so that when plug-in 2 in the ID-000 format is broken out of card body 1 bars 9 do not break." The specification here makes very clear that the "free punch" lines are a separate, earlier step from the breaking out step recited in the claim.

The examiner's interpretation made on page 3 of the 12/17/2004 action by the examiner that US 6,561,432 teaches break-out of the mini-card in multiple directions when the pre-cuts are included was thus improper because the pre-cuts are not part of the break-out.

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Nowhere else in the prior art of record is there any teaching or suggestion to have a miniaturized mini smart card that is part of a mini smart card, which is part of a larger smart card have an arrangement of breaking lines as recited.

It is also noted that the claims were the subject of an international preliminary examination report and were found novel and unobvious.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

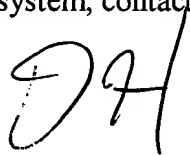
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A. Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

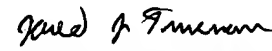
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DH

  
**JARED J. FURMAN**  
**PRIMARY EXAMINER**